

REMARKS

In the above-noted Office Action, the Examiner indicated that the drawing sketches said to accompany the requested amendment to the drawings were not received. Enclosed is another set of set of seven sheets of sketches showing the requested amendment in red as follows: sheet 1 (Fig. 8G); sheet 2 (Fig. 18I); sheet 3 (Fig. 18L); sheet 4 (Fig. 20); sheet 5 (Fig. 23); sheet 6 (Fig. 25) and sheet 7 (Fig. 26).

Also in the above-noted Office Action, various claims were allowed, some were rejected for being unpatentable in view of the prior art and some claims were said to be directed to patentable subject matter but were objected to for depending from rejected independent claims. The prior art rejections are respectfully traversed as set forth below. All claims remain unchanged except for Claim 1 which has been amended as explained below.

Claim 1 was rejected for being unpatentable under §103 over Lollie et al (EP 0404751 hereinafter "Lollie") in view of USPN0. 6,010,157 to Pierson et al (hereinafter "Pierson"). An exemplary embodiment of the apparatus of Claim 1 is shown in Figs 1 and 2 of the subject application. The Claim 1 apparatus can be used in combination with the apparatus of Figs. 4, 5 and 6 to provide a bound book, with the final bound book being shown in Fig. 8J. As can be seen in Figs 1 and 2, an important advantage of the Claim 1 apparatus is that a stack of varying thickness can be bound, with the free edge of the Fig. 4 apparatus being disposed and concealed between the claimed "flap member" and "first cover section" as can be seen in Fig. 8J. As described in detail in the subject application in connection with Figs 8A to 8I, the claimed "first section of pressure sensitive adhesive" and the "second section of pressure sensitive adhesive" and the associated "first release liner" and "second release liner" together with the claimed relative positions of these elements greatly facilitate the assembly of the various components for final binding as shown in Fig. 9 of a stack to produce an attractive end product.

As the Examiner is no doubt aware, when evaluating the subject matter of Claim 1 for purposes of obviousness, it is imperative that one of ordinary skill in the art consider *the problem being solved by the claimed invention*. It is not proper to dismiss arguments regarding the nature of the problem being solved simply because the problem is not specifically claimed. This is in contrast to a rejection based upon anticipation where an intended use would ordinarily be considered irrelevant.

In rejecting Claim 1, a "flap member 4A" is mentioned in the rejection so it is assumed that the embodiment of Fig. 19 of Lollie is being referred to since that is the only embodiment which includes that element. Section 3 of Lollie is said to be the claimed "first cover section" and spine 4A is said to be the claimed "flap member". The "flap member" is said to be "directly attached to the first cover section 3 and pivotable at a first location 6 along the first cover section". A small segment of heat activated adhesive 4 is disposed over part of the cover 3 and that is said to correspond to the "first section of pressure sensitive adhesive" with the remaining portion of adhesive 4 on 4A corresponding to the claimed "second section of pressure sensitive adhesive". Next, the obviousness rejection is completed by citing Pierson for the proposition that the heat activated adhesive segments of Lollie can be replaced with pressure sensitive adhesives and associated release liners.

Initially, it is important to note that claimed "first cover section" (1) has "dimensions that generally correspond to dimensions of the sheets" to be bound; (2) a "first section of pressure sensitive adhesive is disposed along a first edge of the first cover section" and (3) the "first location" where the "flap member" is attached to the "first cover sheet" is "displaced from the first edge of the "first cover section". As shown in Figs 15 and 16 of Lollie, location 6 must be considered the location of the "first edge" of the "first cover section" in order to meet the dimensional limitations of item (1). (The opposite free edge of section 3 is not the "first edge" because there is no "first section of pressure sensitive adhesive" located there as claimed.) Thus, it is clear that location 6 is *not* "displaced from first edge" since they are the same location and further, there is *no* "portion of the first section of pressure sensitive adhesive ... disposed intermediate the first location and the first edge." In addition, Claim 1 has been amended to recite a "free first edge" which further distinguishes over the Lollie structure since the edge of section 3 is not "free" but rather is connected to section 4A.

With respect to the present obviousness type rejection in general, the nature of this rejection leads Applicants to conclude that it is based upon improper hindsight reconstruction. Although the recent Supreme Court in the KSR Int'l may have arguably lowered the bar for "obviousness" rejections, as indicated by the May 3, 2007 Patent Office Memorandum by Deputy Commissioner Focarino " ... in formulating a rejection under 35 USC §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill

in the art would have combined the prior art elements in the manner claimed" (copy of memo enclosed).

Applicants do not believe there are any valid reasons for the claimed combination. Most importantly, there is no reason why a person of ordinary skill would even start with Lolli (other than some meaningless statement such as "the cited prior art all relate to the book binding art"). The Lolli structure cited in the rejection, particularly adhesive 4, is for binding the edge of a stack of sheets whereas the apparatus of Claim 1 is not – two different problems being solved. The claimed "flap member" is intended to be folded over the "first cover section" so as to pivot about a "first location" to that it can be used to secure to an unclaimed second cover element between the "flap member" and the "first cover section". There is no reason why a person of ordinary skill would look at the Lolli structure and conclude that anything beneficial would result towards solving Applicants' problem by envisioning the folding of the structure at line 6. The binding adhesive 4 would then be positioned over cover 3, with the second cover 2 and associated structure extending past the outer edge of cover 3. Clearly, the resultant structure would be incapable of performing any function at all, much less the original function of binding the edge of a stack. It would be even more puzzling to replace the tiny segment of heat activated adhesive 4 of Lollie and replace it with a pressure sensitive adhesive segment covered by a release liner and to further replace the larger segment of adhesive 4 with a pressure segment of adhesive covered by another release liner as allegedly taught by Pierson. This would not improve the stack binding problem of Lolli, particularly with the two separate release liners that provide no particular advantage in this context.

It is clear that the proposed modification of Lollie renders that reference useless for its intended function of binding a stack of sheets. As noted in the MPEP §2145 (page 2100-159, Rev 5, 2006), " ... the claimed combination [of references] cannot change the principle of operation of the primary reference or render the reference inoperable of its intended purpose." Given the lack of any reasonable basis for making the proposed combination, one can only conclude that by selecting certain components of Lollie while ignoring other closely related and interfering components and then modifying those selected components is solely based upon Applicants' own disclosure.

In view of the foregoing, it is believed that the subject matter of Claim 1 is patentable over the cited references. Claims 2 and 3 are believed to be patentable in that they depend from allowable Claim 1 and in that they were found to be directed to patentable subject matter in the subject Office Action.

Claim 15 was rejected for being anticipated by USPN. 4,511,298 to Jones (hereinafter "Jones"). This rejection is also respectfully traversed. An exemplary embodiment of Claim 15 is shown in Figs. 4, 5 and 6 of the subject application. Claim 15 is directed to a bookbinding apparatus which includes a "first cover element" including a "folded sheet" and an "elongated spine element" with "elongated" meaning that the length is greater than the width. A "longitudinal first edge" of the "spine element is attached to the folded sheet adjacent .. [a] fold in the folded sheet, with a longitudinal second edge of the spine element not being attached to the folded sheet". An "adhesive matrix of heat activated adhesive" is disposed on the substrate of the "spine element" with that adhesive being used for binding the edge of a stack as described in the subject patent.

In rejecting Claim 15, it is stated that element 12 of Jones is the "folded sheet" and the "flexible tape member" 14 being the "elongated spine element". Note that the central portion of the tape member 14, which is said to be preferably "clear" [Col. 3, line 61 – 63.] is secured to "foldable member 12" in only the central region of the tape member at intermediate section 26 (see Figs 3 and 5). Tape 4 includes transparent opposing "marginal edge portions 24," each having an inner surface covered by a pressure sensitive adhesive 28 which is in turn covered by a release liner 30. A stack L to be bound is positioned between the marginal edges 24 of tape 4 and held in place by the pressure sensitive adhesive. The transparent edges 24 of tape 4 are said to permit viewing of printed matter on the covers of the bound material.

It can be seen that tape 4 has a "longitudinal first edge" and a "longitudinal second edge", *neither of which* is "attached to the folded sheet adjacent the fold in the folded sheet" as recited in Claim 15. Both edges are free, extending a substantial distance away from member 12. Moreover, if the edges were attached as claimed, it would not be possible to secure the stack L as described. Thus, not only does Jones not anticipate Claim 15, but any modification of Jones by attaching the edges as claimed would defeat the purpose of Jones. Thus, as previously

described in connection with Claim 1, it would not be obvious to somehow modify Jones to arrive at the claimed invention.

In view of the foregoing, it is submitted that Claim 15 is patentable over the cited prior art as are Claims 16 and 17 which depend, either directly or indirectly, from allowable Claim 15 and add patentably significant limitations to the claim.

In conclusion, all pending claims are believed to be in condition for allowance and an early allowance is respectfully requested.

Respectfully submitted,

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By 
Philip A. Girard

Registration No. 28,848

Tel. No. 415/433-2250

Attorney for Applicant

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